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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,559	04/19/2004	Juha Punnonen	0334.210US	5443

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MAXYGEN, INC.
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EXAMINER

HARRIS, ALANA M

ART UNIT	PAPER NUMBER
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1643

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/828,559

Applicant(s)

PUNNONEN ET AL.

Examiner

Alana M. Harris, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 139-158 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 139-158 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 139-158 are pending.
Claims 1-138 have been cancelled.
Claims 139-158 have been added.
Claims 139-158 are examined on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 140, 143 and 152-155 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **THIS IS A NEW MATTER REJECTION.**

Applicants have added new claims including in particular claims 140 and 143, which recite "...amino acid residues 24-265 of SEQ ID NO: 4". Applicants assert support for this new claim language can be found in the specification, including page 32, paragraph 00112. The Examiner has reviewed the entire specification including the designated passage and does note amino acid residues 81-265, but does not see support of Applicants' contemplation of a polypeptide comprising amino acid residues

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24-265 of SEQ ID NO: 4. Applicants should pointedly express where in the specification support can be found for this limitation or delete the new matter.

4. Claims 139-141, 143 and 145-158 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written description in this case only sets forth SEQ ID NO: 4 and amino acid residues 81-265 of SEQ ID NO: 4 as a polypeptide and fragment of said polypeptide able to induce an immune response against human epithelial cell adhesion molecule (EpCAM), therefore the written description is not commensurate in scope with the claims drawn to polypeptide sequences with less than 100% sequence identity to amino acid sequences 24-265 and 81-265 of SEQ ID NO: 4 and a polypeptide that is 96% sequence identical to SEQ ID NO: 4.

Vas-Cath Inc. V. Mahurkar, 19 USPQ2d 1111, clearly states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116).

Applicant is reminded that *Vas-Cath* makes clear that the written description

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provision of 35 U.S.C. 112 is severable from its enablement provision (see page 115).

With the exception of SEQ ID NO:4 and the defined sequence of 81-265 of SEQ ID NO: 4, the skilled artisan cannot envision the detailed structure of the encompassed polypeptides and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and a reference to a potential method of isolating it. The polypeptide itself is required. See *Fiers v. Revel*, 25 USPQ 2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

Furthermore, In *The Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus. The court indicated that while Applicants are not required to disclose every species encompassed by a genus, the description of a genus is achieved by the recitation of a representative number of DNA molecules, usually defined by a nucleotide sequence, falling within the scope of the claimed genus. At section B(1), the court states that "An adequate written description of a DNA...requires a precise definition, such as by structure, formula, chemical name, or physical properties', not a mere wish or plan for obtaining the claimed chemical invention".

Support for a polypeptide and variants and complements defined as 96% sequence identical to the unsupported amino residues 24-265 seems to be nonexistent. This is insufficient to support the generic claims as provided by the Interim Written

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Description Guidelines published in the June 15, 1998 Federal Register at Volume 63, Number 114, pages 32639-32645.

Therefore, Applicants seem to only be in possession of the polypeptide, SEQ. ID. NO:4 and the defined sequence of 81-265 of SEQ ID NO: 4 with corresponding function and consequently not the full breadth of the claims meets the written description provision of 35 U.S.C. 112, first paragraph.

5. Claims 139-141, 143 and 145-158 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement commensurate with the scope of the claimed invention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Claims 139-141 and 143-158 are broadly drawn to an isolated polypeptide comprising a sequence which is at least 96% identical to amino acid residues 81-26 and 24-265 sequence SEQ ID NO: 4 and a polypeptide sequence, which has at least 96% sequence identity 81-265 and 24-265 of SEQ ID NO:4. The specification while being enabling for the polypeptide identified as SEQ ID NO: 4 and a peptide comprising 81-265 amino acid residues, does not reasonably provide enablement for variants that have at least 96% sequence identity and fragments of the polypeptide that more than likely do not encode protein with the ability to induce an immune response against human EpCAM. Moreover, a polypeptide sequence probably does not encode a protein. There is no guidance as to how to make these divergent sequences. The

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polypeptides with 96% sequence identity to SEQ ID NO: 4 and to fragments of SEQ ID NO: 4 may possess function that is not commensurate with the functions of the native protein. These proteins may not maintain the activities proposed in the specification. Likewise, it would seem that specific function(s) would be required to make the encoded protein useful for the applications disclosed in the specification. Since the amino acid sequence of a polypeptide determines its structural and functional properties, predictability of which changes can be tolerated in a polypeptide's amino acid sequence and still retain similar activity requires a knowledge of and guidance with regard to which amino acid or acids in the polypeptide's sequence, if any, are tolerant of modification and which are conserved and detailed knowledge of the ways in which the protein's structure relates to its function. The specification provides essentially no guidance as to which of the infinite possible choices is likely to be successful. The true fact of the state of the art in peptide chemistry is expressed succinctly in the accompanying Lazar article (Molecular and Cellular Biology 8(3): 1247-1252, March 1988). This article presents data that substantiates the fact that the introduction of mutations in an amino acid sequence will yield products with different biological activity from the wild type protein.

From the discussion above, it is clear that the predictability of changes to the nucleic acid sequence and its forthcoming amino acid sequence is practically nil as far as biological activities are concerned. The specification fails to provide sufficient guidance to enable one of ordinary skill in the art to make and use the claimed nucleic acids in a manner reasonably correlated with the broad scope of the claims. Without

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such guidance, the changes which must be made in the mutant polypeptides of SEQ ID NO: 4, which results in proteins with 96% identity comprising 24-265 and 81-265 of SEQ ID NO: 4 is unpredictable and the experimentation left to those skilled in the art is unnecessarily and improperly extensive and undue. See *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016 and *Ex parte Forman*, 230 USPQ 546 (BPAI 1986).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the instant case, the recitation "...comprising amino acid residues 24-265 of

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SEQ ID NO: 4" listed claims 140 and 143 do not further limit from independent claim 139.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 139-158 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2005/0009097 A1 (effective filing date March 31, 2003). Sequence 54, epithelial cell adhesion molecule (Ep-CAM) of US Patent Application Publication shares at least 96% sequence identity to Applicants' 24-265 and 81-265 amino acid residues of SEQ ID NO: 4. The Ep-CAM antigen can be used to produce antibodies, see page 6, sections 0073 and 0074. The application also discloses the molecule in a PBS solution, see page 25, section 0276. Inherently, the disclosed polypeptide possesses all the functions and activities limited in Applicants' claims. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

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10. Claims 139-158 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,645,498 B1 (filed March 30, 1995). Sequence 2, GA7366-2E is a monoclonal antibody defined antigen and shares at least 96% sequence identity to Applicants' 24-265 and 81-265 amino acid residues of SEQ ID NO: 4, see column 1, lines 40-42 and column 2, line 55-column 3, line 20. The GA733-2E is comprised in pharmaceutical compositions, see column 8, line 6-column 9, line 65. Inherently, the disclosed polypeptide possesses all the functions and activities limited in Applicants' claims. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571)272-0831. The examiner can normally be reached on 7:30 am to 6:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALANA M. HARRIS, PH.D.

PRIMARY EXAMINER


Alana M. Harris, Ph.D.
08 January 2007